

REMARKS**I. General**

The issues outstanding in the instant application are as follows:

- Claims 1-5 and 8-19 stand rejected under 35 U.S.C. 112, second paragraph as being vague and indefinite;
- Claims 1-5 and 10-19 stand rejected under 35 U.S.C. §103(a) as unpatentable over Templeman, U.S. Patent No. 5,845,303 (hereinafter *Templeman*) in view of Nielsen, U.S. Patent No. 5,897,644 (hereinafter *Nielsen*); and
- Claim 9 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Templeman* in view of *Nielsen* and further in view of Lemay, Laura, Teach Yourself Web Publishing with HTML in a Week, Sams Publishing, 1995, pp. 306, 346, 348 (hereinafter *Lemay*).

Applicants hereby traverse the outstanding rejections of the claims, and request reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. Claim 10 is amended above to correct a typographical error. Claims 1-5 and 8-19 are currently pending in this application.

II. Rejections under 35 U.S.C. §112, second paragraph

Independent claims 1, 10, 11 and 12 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite and claims 2-6, 8-9, and 13-19 stand rejected for incorporating the alleged deficiencies of their respective base claims. Specifically, the words “susceptible to influence” in claims 1, 10, 11 and 12 are asserted by the Office Action as being vague and indefinite. Further, the Office Action states “It is unclear if said claimed layout is actually being influenced.”

Applicants respectfully remind the Examiner that Applicant may be his own lexicographer, *Lear Siegler, Inc. v. Aerogrip Corp.*, 221 USPQ 1025, 1031 (Fed. Cir. 1984). Applicants also respectfully remind the Examiner that according to the M.P.E.P. §2173.02, the Examiner “should allow claims which define the patentable subject matter with a

reasonable degree of particularity and distinctness.” Applicants submit that the use of the phrase “susceptible to influence ” does not make the claim indefinite. Applicants assert that the use of the term “susceptible to influence”, particularly in the context it is presented in claims 1, 10, 11 and 12, (i.e. where the “layout is susceptible to influence by browser configuration” on a second or other computer) is not giving a meaning to the term repugnant to its usual meaning. Since the Office Action states “It is unclear if said claimed layout is actually being influenced” (emphasis added), Applicants assume that the bothersome word is “susceptible”. *Webster’s Encyclopedic Unabridged Dictionary* defines “susceptible” as “2. “accessible or especially liable or subject to some influence, mood, agency, etc.”, 1996, p. 1917, a copy of which is attached hereto as Exhibit 1. Therefore, the use of “susceptible to influence” in claims 1, 10, 11 and 12 is clearly in agreement with the common and ordinary meaning of the word “susceptible” and is not giving a meaning to the term repugnant to its usual meaning. Therefore applicants respectfully request that the 35 U.S.C. § 112, second paragraph, rejection of claims 1, 10, 11 and 12 be withdrawn.

III. Rejections under 35 U.S.C. §103(a)

Claims 1-5, 8 and 10-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Templeman* in view of *Nielsen*. Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Templeman* and *Nielsen* in view of *Lemay*. Applicants respectfully traverse these rejections.

A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the second criteria, Applicants respectfully assert that the rejection does not satisfy the first and/or third criteria.

1. The recited combination does not teach or suggest all claimed limitations.

A. Claims 1-5, 8 and 10-19

The Office Action admits that *Templeman* does not teach having a “layout presentation influenced by browser configuration.” The Office Action attempts to cure this deficiency by introducing *Nielsen*, which the Office Action alleges to teach having “a transformation that transforms a web page (preserving an aspect ratio), for display in an HTML processing application (i.e. a web browser) in output devices of differing sizes.”. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Independent claim 1 defines “determining, using a first computing system, a primary split direction for the web page” and “determining splits of the web page, in the primary split direction”. Independent claim 10, as amended, defines similar limitations in a means plus function format. Similarly claim 11 recites “determining a primary split direction for the web page” and “determining splits in the web page, in the primary split direction”. Independent claim 12 recites “a device for obtaining a primary split direction for the web page” and “memory storing software code for determining splits in the web page, in the primary split direction”. *Templeman* as modified by *Nielsen* does not disclose at least these limitations.

As discussed at column 5, lines 30 through 52, *Templeman* discloses a metaform employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data. For example, frames 88 and 90 contain the body of the newsletter. Examples of metaforms listed include memos, business letters, newspaper articles, electronic mail messages, technical reports, and the like. The type of data each frame may accept is determined by a tag or set of tags which identifies the frame as accepting certain data. These tags correspond to tags used to identify input data.

The Office Action states “It is noted that said newsletter frameset (Figure 3A) incorporates two main body columns, separated by a main vertical split which is determined by the template. This can be interpreted as a primary split direction, said split direction typical of many newsletters and newspapers.”. However, as cited by the Office Action and taught by *Templeman*, at column 8, lines 60-65, “distances between columns 130d or widths

of columns 130e, 130f may also be defined using required constraints”. *Templeman* also states that “A constraint describes a relationship that must hold between multiple variables. For example, a constraint can be defined which will maintain an alignment between two objects...constraints are employed to maintain consistent relationships between frames as the frames change size and/or location on the display device 44.” Therefor, *Templeman* requires that column or row relationships be defined as constraints. In other words, the metaforms of *Templeman* defines or sets column spacing while the present invention determines both a primary direction of splits on a web page and the splits themselves, in that primary direction. Furthermore, *Templeman* is silent as to splits in general and as to determining a primary direction of splits on a web page. Any splits and their directions present in *Templeman* are predefined in the metaform.

Thus, *Templeman* does not teach the claimed “determining a primary split direction...for a web page” or “determining splits of the web page, in the primary split direction” and *Nielsen* is not relied upon as teaching this limitation. Therefore, for at least these reasons Applicants respectfully assert claims 1, 10 11 and 12 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Independent claims 1, 10, 11 and 12 all define a “layout is susceptible to influence by browser configuration”. Despite the contention of the Office Action, *Nielsen* does not disclose this limitation.

As shown in FIGURES 9A through 9C of *Nielsen*, and discussed in the abstract, *Nielsen* discloses “a page layout similar to that of the original but magnified or reduced to fit the available display area” (emphasis added). Furthermore, at column 3, lines 32 through 37 *Nielsen* states “the invention specifies the size of the fixed canvas used to create the presentation and transforms (reducing or enlarging) the canvas and image (resulting from processing the HTML data stream) to fit on a display with a different size than the display used to create the original presentation”. The disclosure of *Nielsen* seems be limited to issues of display and font size, not all aspects of a web page layout that are susceptible to influence by browser configuration, such as browser default font sizes which would block or otherwise interfere with the font resizing taught by *Nielsen* and which can be compensated for by the determination of splits as recited in the present independent claims. Therefore, Applicants

respectfully assert that for at least this reason claims 1, 10, 11 and 12 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-5, 8 and 13-19 ultimately depend from base claims 1 and 12, and thus inherit all limitations of their respective base claims. Resultantly, each of claims 2-5, 8 and 13-19 set forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons as detailed above in relation to base claims 1 and 12. Furthermore, many of these dependent claims recite limitations not present in *Templeman* and *Nielsen*. Therefore, Applicants respectfully assert that for the above reasons claims 2-5, 8, and 13-19 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Examiner's Personal Knowledge (Claims 1 and 8)

In the rejection of claim 1, the Office Action states "It is noted that said newsletter frameset (Figure 3A) incorporates two main body columns, separated by a main vertical split which is determined by the template. This can be interpreted as a primary split direction, said split direction typical of many newsletters and newspapers." (Emphasis added.) In the rejection of claim 8, the Office Action states "a publish request from a user would have been obvious to one of ordinary skill in the art at the time of the invention". In light of these statements by the Examiner, Applicants believe that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to these matters. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertions. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference(s) in support of the assertions. Otherwise the rejection of claims 1 and 8 should be withdrawn.

B. Claim 9

The Office Action admits that *Templeman* as modified *Nielsen* does not teach "a preview request." The Office Action attempts to cure this deficiency by introducing *Lemay* which the Office Action alleges to teach having "an HTML writer utilizing a Test (preview)

button.” However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 9 ultimately depend from independent base claim 1, through intermediate dependent claim 5, and thus inherits all limitations of claim 1. Resultantly, claim 9 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons as detailed above in relation to claim 1. Furthermore, *Lemay* is not relied upon as teaching any of the limitations absent from *Templeman* as modified by *Nielsen* discussed above. Therefore, Applicants respectfully assert that for this reason alone claim 9 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Furthermore, claim 5, the parent claim of claim 9, recites “generating an internal representation of the web page” and claim 9 itself defines “the generating step is performed after receiving a preview request from a user”. *Lemay* does not disclose at least the emphasized limitation of claim 9’s parent claim. *Lemay* states: “it [HTML Writer] has a test preview button that loads Mosaic or Cello to preview your work. Therefore, *Lemay* does not teach generation of an internal representation of a web page but rather teaches the loading of an external program to preview work. Thus, *Lemay* does not teach the claimed generating an internal representation of the web page after receiving a preview request from a user, and in truth, teaches away from this limitation. The Office Action fails to address this aspect of claim 5. Therefore, the Applicants respectfully assert that for the above reasons claim 9 is patentable over the 35 U.S.C. § 103(a) rejection of record.

2. The Office Action does not provide the requisite motivation.

A. Claims 1-5, 8 and 10-19

The Office Action admits that *Templeman* does not teach having a “layout presentation influenced by browser configuration.” The Office Action attempts to cure this deficiency by introducing *Nielsen*, which the Office Action alleges to teach having “a transformation that transforms a web page (preserving an aspect ratio), for display in an HTML processing application (i.e. a web browser) in output devices of differing sizes.”. The motivation for making the combination was presented as follows:

"It would have obvious to one of ordinary skill in the art at the time of the invention to apply Nielsen to Templeman, providing Templeman the benefit of web page display resizing within Templeman's relationship constraints (Templeman column 8 lines 41-48) in web browsers for fitting various sized devices (i.e. laptops, PDAs, etc.).

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. Language such as advanced by the Office Action is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The statement "providing Templeman the benefit of web page display resizing within Templeman's relationship constraints... in web browsers for fitting various sized devices", is merely a restatement of the proposed combination not a reason or motivation for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Templeman* and *Nielsen* is desirable. Therefore, the rejection of claims 1-5, 8 and 10-19 should be withdrawn.

Hindsight

Applicants respectfully assert that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure. Applicants assert that without the teachings of Applicants' disclosure one of ordinary skill in the art would not find it obvious to determine the direction of splits in a web page and then define splits in the determined direction from the disclosures of *Templeman* and *Nielsen*.

Templeman teaches the use of predefined metaforms employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data, whereas *Nielsen* teaches magnifying or

reduced a page layout to fit the available display. Therefore each reference teaches a complete method for displaying a page without the need of the teachings of the other reference. Conversely, the teaches of each of the references would interfere or destroy the function of the other reference. The reduction or enlarging of a page would violate the constraints of *Templeman* and the use of constraints would prevent reduction and enlargement of a page as taught by *Nielsen*. It is well settled that the proposed modification cannot render the prior art unsatisfactory for its intended purpose, M.P.E.P. §2143.01. If the proposed modification rendered the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

The Examiner seems to be relying on the teachings of the present application to conclude that one of ordinary skill in the art would be motivated to resize a web page display within relationship constraints in a web browser for fitting various sized devices. It is respectfully asserted that such a conclusion ignores the teachings of both *Templeman* and *Nielsen*.

B. Claim 9

The Office Action admits that *Templeman* as modified *Nielsen* does not teach “a preview request.” The Office Action attempts to cure this deficiency by introducing *Lemay* which the Office Action alleges to teach having “an HTML writer utilizing a Test (preview) button”. The motivation for making the combination was presented as follows:

“It would have been obvious to one of ordinary skill in the art at the time of the invention to apply *Lemay* to *Templeman*, providing *Templeman* the benefit of previewing a page after importation of HTML data, to see if said importation was successfully integrated.”

As noted above, it is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01.

Lemay teaches away from the present invention. The third paragraph on page 326 of *Lemay* states: “on the other hand, if you go looking for a full-featured HTML editor that lets you quickly see the result of your work, insert links and anchors and inline graphics quickly and easily, or build a form using element widgets you can drag from a toolbox, you’ll be looking for a very long time” (emphasis added). Thus, *Lemay* teaches that the claimed elements of the present invention, namely, “preserving a preferred layout of said web page when rendered by one or more second computing systems, wherein said preferred layout is susceptible to influence by browser configuration on said one or more second computing systems” are absent from the prior art. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Templeman* as modified *Nielsen* with *Lemay* is desirable. Therefore, the rejection of claim 9 should be withdrawn.

Hindsight

Applicants respectfully assert that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure. Applicants assert that without the teachings of Applicants' disclosure one of ordinary skill in the art would not find it obvious to provide *Templeman* as modified by *Nielsen* the benefit of previewing a page after importation of HTML data, to see if said importation was successfully integrated. As pointed out above *Lemay* teaches away from “a full-featured HTML editor that lets you quickly see the result of your work”

The Examiner seems to be relying on the teachings of the present application to conclude that one of ordinary skill in the art would be motivated to providing modify the metaforms of *Templeman* to have the benefit of previewing a page. It is respectfully asserted that such a conclusion ignores the teachings of. *Templeman* , *Nielsen* and particularly *Lemay*.

IV. Conclusion

For all the reasons given above, the Applicants submit that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103, and meet the requirements of 35 U.S.C. § 112). Accordingly, the Applicants submit that this application is in full condition for allowance. Therefore, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

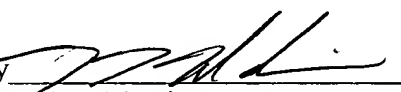
Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 47583/P029US/10205730 from which the undersigned is authorized to draw.

Dated: March 17, 2003

Respectfully submitted,

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Version With Markings to Show Changes Made

In the Claims

10. (Amended) A system comprising:
- means for obtaining a layout of display elements on a web page;
 - means for determining a primary split direction for the web page, said primary split direction preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other system [second system], wherein said preferred layout is susceptible to influence by browser configuration on said web browsers hosted by at least one other system; and
 - means for determining splits for the web page, in the primary split direction.